

C. APPLICANT'S COMMENTS

Claims 1-16 are pending in this Application, with Claims 1, 16 being amended. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-16 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 1 of the Official Action

The Applicant has amended Claim 16 to clarify that the sandbag is actually being positioned beneath the "front portion" of the firearm. The Applicant appreciates the Examiner's attention to this matter.

Paragraph 2 (Numbered Paragraph 1) of the Official Action

The Official Action rejected as-filed Claims 1, 3, 14, 15 under 35 U.S.C. §102(b) as being anticipated by Schubler (DE 3204082). The Applicant respectfully disagrees with this rejection particularly in view of the amendments made to the claims.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987) (emphasis added). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Independent Claim 1 has the following features:

1. (Currently Amended) A pneumatic gun alignment system for adjusting the position of a firearm, comprising:

a support bag having an upper surface, wherein said support bag is inflatable and is only positionable directly beneath a firearm so that said upper surface is in engagement with a lower portion of a firearm for adjusting the vertical position of a firearm; and

a hose having a first end and a second end, wherein said first end is fluidly connected to said support bag and wherein said second end is fluidly connectable to an air supply unit.

Schubler does not teach a structure design for, much less capable of, "adjusting the vertical position of a firearm". This is a significant improvement within the present invention not shown in the prior art. The support bag of the present invention is inflated (or deflated) to adjust the vertical position of the rear portion (or the front portion) thereby adjusting the vertically orientated angle of the firearm during aiming of the same.

Schubler merely teaches "a pressure cuff (8) which, when pressure ... is supplied, lays itself firmly round the stock (10a)". The pressure cuff of Schubler does not allow for vertical (or even horizontal) movement of the rear portion of the firearm. In fact, the purpose and functionality of the pressure cuff in Schubler is to prevent movement of the rear portion of the rifle during firing. This is a completely opposite purpose and functionality of the present invention which is intended to elevate/lower the rear portion (or front portion) of the firearm

during aiming. To further support this, Schubler clearly shows the "pressure cuff" surrounding the entire stock of the firearm (see Figure 1). With the pressure cuff surrounding the entire stock of the rifle, when the pressure is increased the vertical position of the firearm stays the same since an equal pressure is extending downwardly upon the upper portion of the firearm by the upper portion of the pressure cuff. Hence, if the user of Schubler wanted to raise/lower the rear portion of the firearm with the pressure cuff, they couldn't. That is why Schubler teaches the adjustment of the front portion of the rifle by rotating the threaded support legs (5) via the handles (5a).

The Applicant respectfully submits that Schubler does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Schubler does not disclose (expressly or inherently) all of the elements of Claims 1, 3, 14, 15.

Paragraphs 3-7 (Numbered 2-6) of the Official Action

The Official Action rejected Claims 2, 4-13 under 35 U.S.C. §103(a) as being unpatentable over Schubler in view of Wold, Hill et al. and Killian. The Applicant respectfully disagrees with this rejection of these claims, particularly as the same are now amended.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law

which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

The Official Action states that Wold (U.S. Patent No. 3,012,350) teaches a "front support bag (66) beneath the front portion of a firearm (12). However, Wold merely teaches a "narrow sandbag 66 positioned in the cradle member 26" that supports the forearm of the rifle 12 and "a relatively large flat sandbag 68" that supports the butt/heel of the gunstock (see Figure 1 of Wold; see also Column 3, Lines 22-40). Wold does not teach the usage of a support bag that is inflatable for adjusting the vertical position of the firearm for aiming purposes. Hill et al. (U.S. Patent No. 5,875,580) does not teach an airbag covered by a permeable material as it merely teaches a "sand-filled canvass bag". (Column 1, Lines 27-29).

First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Schubler or to combine reference teachings – Schubler was designed solely for the purpose of firmly retaining the rear stock of the firearm during firing in a non-movable position which is the opposite purpose of the present invention which is intended to allow for finite adjustment of the aiming position of the firearm. Second, there is no reasonable expectation of success of combining the references (e.g. you cannot use Wold as an airbag as it merely teaches a "sandbag"). Finally, the prior art references must teach or suggest all the claim limitations – none of the references teach an airbag that provides adjustable supporting of a fire arm (much less a method of using the same).

Finally, Killian (U.S. Patent No. 5,819,461) merely teaches an "apparatus for steadying a device to be aimed by a user" that is comprised of an arm rest for a human elbow that has an upper portion and a lower portion for steadying the arm of the person at the elbow region. One skilled in the art of firearms would not have known about Killian nor would they have been

inclined to combine Killian with Schubler as suggested in the Office Action. Killian is a non-analogous reference which should not be considered in determining the patentability of the present invention. "The determination that a reference is from a non-analogous art is . . . twofold. First, we decide if the reference is **within the field of the inventor's endeavor**. If it is not, we proceed to determine whether the reference is **reasonably pertinent to the particular problem with which the inventor was involved**." *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979). "A reference is **reasonably pertinent** if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992).

First, Killian is not within the field of the inventor's endeavor (i.e. adjustably supporting a firearm for aiming purposes). Second, Killian is not reasonably pertinent to the particular problem with which the inventor was involved. Killian is directed towards the problem of human arms becoming fatigued over time after holding an object such as a camera or telescope. Killian does not solve any problems associated with a support stand for adjustably supporting a firearm wherein the airbag may be inflated/deflated to raise/lower a portion of the firearm for aiming purposes.

The Applicant also respectfully submits the following case law in support that the prior art stated in the Official Action is non-analogous:

- "In resolving the question of obviousness under 35 USC 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. . . . The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art." *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).
- "In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum,

is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. . . . Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness." Ex parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

- "We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" . . . —in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).
- "The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories. . . . Wang's SIMMs were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. . . . In contrast, the Allen-Bradley patent relates to a memory circuit for a larger, more costly industrial controller. . . . Thus, there is substantial evidence in the record to support a finding that the Allen-Bradley prior art is not reasonably pertinent and is not analogous." Wang Labs., Inc. v. Toshiba Corp., 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993).


For these reasons, among others, the combination of Schubler with Wold, Hill et al. or Killian (non-analogous) cannot suggest the combination of features in applicant's Claims 1-16, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1-16 allowed.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels

this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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